

**REMARKS – general**

Applicant acknowledges the new prior art by Perry cited by the examiner and considered pertinent to applicant's disclosure. Applicant has amended the specification to include a brief discussion of Perry's prior art.

Additionally, applicant has amended the claims to define the invention more particularly and distinctly so as to overcome the rejections of the office action of April 20, 2005 and to define the invention patentably over the prior art. No new matter has been added.

The last office action rejected claims 1 – 4 under 35 U.S.C. 102(b) variously on Milani, Huang, Kirk, and Obergfell. The same office action rejected claim 5 under 35 U.S.C. 103(a) over Obergfell in view of Huff.

Applicant has addressed each of these rejections in the following paragraphs. Applicant has also amended the claims to define the invention more particularly and distinctly.

Applicant has also included evidence showing that the invention of this application has already been licensed by L&N Sales and Marketing, the leading manufacturer of hair accessories in North America and now a division of Conair Corporation. A sample package being used commercially for selling the invention of this application has also been included.

### **The Rejection of claims 1, 2 and 4 on Milani**

The last office action rejected claims 1, 2 and 4 as being anticipated by Milani. Applicant has amended claim 1 to better reflect the novelty of the current invention over Milani and to make it allowable. Since claim 2 is dependent on claim 1, applicant requests that it be allowed as well. Claim 4 has been canceled. Applicant requests reconsideration of amended claims 1 and 2 for the following reasons:

- a) The device by Milani is a multi-piece structure that includes a visor of a rigid material, a cylindrical band of a soft fabric and two elastic bands attached to the soft fabric band.

In contrast the invention of the current application is a much simpler device. In its preferred embodiment, the slit is an integral part of the cylindrical band which is a single piece of material. This simplicity is one that is immediately apparent and that distinguishes the band of the current invention from Milani's visor. This makes the current invention both distinct and novel over Milani's visor. The visor portion of Milani's device not only makes it structurally different from the headband of the current invention but it also limits the applications of Milani's device. For instance, Milani's device cannot be used as an all-occasion fashion accessory. Someone sporting the visor of Milani's invention would look very odd indoors at, say, a meeting or in a classroom or at the movies. On the other hand the headband of the current invention can be worn at any occasion including at work, at school, even while resting lying down. Thus, the absence of a visor in the headband of this invention is very important.

- b. The current invention is not only novel but also unobvious over Milani. The current invention solves a different problem. The band of this invention is intended for use as a headband. It helps keep the wearer's hair away from the face. It can be worn during any activity including sleeping, washing ones face, applying makeup, etc. In contrast, Milani's visor is not intended for and, indeed, cannot be worn to sleep, to wash ones face, to apply makeup, etc.
- c. The current invention is unobvious over the prior art reference for yet another reason. It has a much simpler and, therefore, elegant design. Most stores that sell hair accessories already sell headbands that consist of a cylindrical band of flexible fabric. Thus manufacturing processes are already in place to create simple cylindrical headbands. The current invention takes such an ordinary headband and elevates it to a much more functional accessory by simply incorporating a slit in it. Thus the headband of the current invention can be manufactured inexpensively by minor modifications to existing processes. In contrast, Milani's invention which consists of several pieces of different materials requires complex manufacturing almost to the extent to make it much less viable commercially.
- d. The headband of this invention is licensed to one of the largest manufacturers of hair accessories in this country, L&N Sales and Licensing (also known as Scunci International), now a division of Conair Corporation. L&N Sales and Marketing is a

company known for its savvy in the hair accessory industry. It is a company that owes part of its success to licensing successful hair accessory inventions. That such a company with intimate familiarity with the world of hair accessories licensed the headband of this invention is another evidence of the novelty and unobviousness of this invention. Applicant has enclosed evidence of the licensing agreement with L&N Sales and Marketing.

For all these reasons explained above, applicant feels that the headband of the current invention is both novel and unobvious over Milani's. This is particularly true since the invention is classified in a crowded art. Keeping in mind examiner's objection, and to underline the simple design of the applicant's invention while making the absence of a rigid visor more distinct, claim 1 has been modified to include the following line: "said headband and ponytail retaining device being contained entirely within said circumference and said width". Claim 2 is dependent on claim 1 so it has been implicitly modified. It has been directly amended as well to read, "The device of claim 1 wherein said elongated opening is created incorporated into said cylindrical band portion by means of a slit by making an elongated slit created directly in the material of the cylindrical band portion with said slit being substantially parallel to the circumference of said cylindrical band". This amendment creates the distinction that the slit in the invention of the current application exists integrally in the material of the band in contrast with Milani's device in which the slit exists between two bands of elastic attached separately to the band portion. Claim 4 has been canceled.

### **The Rejection of Claims 1, 2 and 4 on Huang**

The last office action rejected Claims 1, 2 and 4 as being anticipated by Huang.

Applicant has amended the claims to better reflect the novelty of the current invention

over Huang. Applicant requests reconsideration of this rejection for the following reasons:

a) The device by Huang (Fig 2) is not a closed cylinder as opposed to the device of this invention. This seemingly small difference translates to a very big difference in functionality. The last office action mentioned that Huang's invention is a cylinder as shown in Fig 4. However, the same Fig 4 shows that Huang's device necessarily incorporates a knot where the two open ends of axial member 20 are brought together. It can be seen in Fig 4 that a user would have to tie forked tails 13 together to hold axial member 20 of Huang's device into a cylindrical shape. The presence of the knot in Huang's device makes it a more contrived invention as compared to the current invention. Huang's device in fact lacks the simple elegance of the device of the current invention.

The headband of the current application is a simpler device than Huang's in structure, construction and ease of use. In its preferred embodiment, the slit of the current invention is an integral part of the cylindrical band which is a single band of material. There is no knot in contrast with Huang's device. Instead, there is a continuous cylinder of fabric. This simplicity is one that is immediately apparent and that distinguishes the band of the current invention from Huang's "clip". This makes the current invention both distinct and novel over Huang's."

b) The current invention is not only novel but also unobvious over Huang's. The current invention is much quicker and easier to use. With Huang's invention, the user would have to spend extra time tying the ends of the axial member 20 together. As most users know, today's busy women have very little time to waste when it comes to grooming. For instance, a woman who wants to hold her hair back while she washes her face before bed-time would not be happy about taking extra time to tie Huang's headband around her head. In contrast, the headband of the current invention would be very quick to use. The user would just need to slip it over their head and then pull their ponytail through without having to fumble with knots. In addition, aesthetically also the headband of this invention is far superior to Huang's. A trendy teenager headed for school or the beach would be unlikely to wear Huang's headband with its knot at the top. In contrast, the headband of the current invention can be worn to just about any event from school to malls to evenings out.

c) The current invention is unobvious over prior art for yet another reason. It has a much simpler and, therefore, elegant design. Most stores that sell hair accessories currently sell headbands that consist of a cylindrical band of flexible fabric. Thus manufacturing processes are already in place to create simple cylindrical headbands. The current invention takes such an everyday headband and elevates it to a much more functional accessory by simply incorporating a slit in it. By comparison, Huang's invention is much more contrived.

d) The headband of this invention is licensed to one of the largest manufacturers of hair accessories in this country, L&N Sales and Marketing (also known as Scunci International), now a division of Conair Corporation. L&N Sales and Marketing has built its business on licensing hair accessory inventions and commercializing them. That they licensed the headband of this invention with their familiarity with the world of hair accessory inventions is evidence of the novelty and unobviousness of this invention.

Huang's device is axial. In contrast the device of the current invention is cylindrical. Claim 1, in fact, explicitly mentions that the headband of this invention is cylindrical. The word "continuous" has been added to claim 1 to further highlight the distinction between Huang's device and the headband of this invention. Besides, the amendment made to claim 1 for patentability over Milani also makes it patentable over Huang since it highlights the fact that the cylindrical band has a simple design with no extraneous elements such as visors and knots. Claim 4 has been canceled.

### **The Rejection of Claims 1 and 3 on Kirk**

The last office action rejected Claims 1, 3 as being anticipated by Kirk. Applicant has amended claim 1 to better reflect the novelty of the current invention over Kirk. Claim 3 has been canceled. Applicant requests reconsideration of amended claim 1 for the following reasons:

a) The device of the current invention is both novel and unobvious as compared to the device by Kirk. For instance, the opening between bands 1 and 2 of Kirk's device is not

simply a slit in a cylindrical band. This is clear from Fig 1 of the prior art as well as from Kirk's description (column 3, lines 16-25). In Kirk's device, band 2 is rigidly fixed to band 1 at an angle of approximately forty-five degrees. Also, in column 2, lines 72-75 Kirk states that "The band 2 is positioned with a definite relation to band 1, in order to hold the ends of the front hair". Thus, if the opening between bands 1 and 2 in Kirk's device was a mere slit with bands 1 and 2 being substantially parallel and adjacent then it would be contrary to Kirk's own teaching which requires that the spacing and angle between bands 1 and 2 be such that band 1 hold down the front hair at the roots while the band 2 hold down the ends of the front hair. In contrast, the structure of the headband of the current invention is much simpler. Instead of forming an opening by placing one band transversely at an angle to a cylindrical band, the device of the current invention has a simple slit incorporated into the structure of a cylindrical band. This seemingly small difference translates to a very big difference in functionality.

b) The current invention is not only novel but also unobvious over Kirk's. The current invention is directed towards a different function. Kirk's device is used to hold the front hair down both at the roots and at the ends. If Kirk's device is worn in a manner similar to the headband of this invention it will not work as intended because the opening between bands 1 and 2 of Kirk's device will be too large to hold a ponytail snugly. Even if buckle 4 in Kirk's device is tightened, the vertical opening between bands 1 and 2 will remain large. All that the tightening will do is modify the size of the opening laterally causing an unattractive, misshapen opening. Thus, aesthetically also the headband of this invention is superior to Kirk's.

c) The current invention is unobvious over prior art for yet another reason. It has a much simpler and, therefore, elegant design. Most stores that sell hair accessories currently sell headbands that consist of a cylindrical band of flexible fabric. Thus manufacturing processes are already in place to create simple cylindrical headbands. The current invention takes such an everyday headband and elevates it to a much more functional accessory by simply incorporating a slit in it. By comparison, Kirk's invention is much more contrived as well as difficult to manufacture. It includes two separate bands that have to be put together in a very specific configuration. Additionally, Kirk's device includes buckles. Kirk's device is also non-intuitive to use since it requires tightening of two sets of buckles independently.

d) The headband of this invention is licensed to one of the largest manufacturers of hair accessories in this country, L&N Sales and Licensing (also known as Scunci International), now a division of Conair Corporation. L&N Sales and Licensing, despite its familiarity with the world of hair accessories, considered the headband of this invention novel enough to license it immediately on seeing it. Since then the headband is being sold through various retailers as a Cosmetic Wrap. This commercial acquiescence is testament to the unobviousness of the current invention.

For all these reasons, applicant claims that the invention of the current application is both novel and unobvious over Kirk's device. In order to better highlight the differences with the prior art device, applicant has modified claim 1 to include the following, "said opening being of a dimension to hold the wearer's ponytail snugly".

**The Rejection of Claims 1 on Obergfell under U.S.C. 102(b)**

The last office action rejected Claim 1 as being anticipated by Obergfell. Applicant has amended the claims to better reflect the novelty of the current invention over Obergfell. Applicant requests reconsideration of the amended claim for the following reasons:

- a) The device of the current invention is both novel and different as compared to the device by Obergfell. The slit in the device of the current invention is necessarily an elongated opening. This is important to prevent the kink that forms in hair when hair is bundled into a conventional ponytail. The device illustrated and described by Obergfell does not have an elongated opening. It has a small aperture that constrains hair into a small opening. In Obergfell's words, column 1, lines 49-54: "the band including an aperture for receiving a ponytail therethrough, and a second band adapted for encircling and holding a person's ponytail, the second band being attached to the first band and defining a second aperture aligned with the first aperture and sized to receive the ponytail therethrough." Obergfell also writes, column 2, 49-51: "The second band 15 includes attachment means for selectively adjusting the size of the band to snugly retain therein the person's ponytail". The use of an aperture in Obergfell's device as opposed to the elongated slit of the current invention is an important structural difference that translates to functional difference. The aperture of Obergfell's device will result in a kink in the wearer's hair. Thus once Obergfell's device is used on a wearer's hair, she will have to restyle her hair to wear it open without a headband. In contrast, the slit in the headband of the current invention does not cause a kink in the wearer's hair. Thus a wearer can use

the headband of the current invention without having to restyle her hair after removing the headband. This is because the slit in the headband holds hair snugly but without bundling it into a small diameter.

- b) Another structural difference between Obergfell's device and the headband of the current invention is that Obergfell's device has a more complex structure. As described by Obergfell, column 3, lines 16-22: "in the simplest form, the ponytail holder 14 is a relatively flat band of material formed in the shape of a donut, and stitched together as needed. The headband may similarly comprise a flat band having ends which are secured to the interior portion of the donut-shaped ponytail holder by stitching". In contrast, the headband of the current invention does not include a separate ponytail holder and a separate band. In its preferred embodiment, the headband consists simply of a cylindrical band of fabric with a slit incorporated into the band itself.
- e) For the above reasons, the current invention is not only novel but also unobvious over Obergfell's. In contrast to Obergfell's device, it has a much simpler and, therefore, elegant design. Most stores that sell hair accessories currently sell headbands that consist of a cylindrical band of flexible fabric. Manufacturing processes are already in place to create simple cylindrical headbands. The current invention takes such an everyday headband and elevates it to a much more functional accessory by simply incorporating a slit in it. By comparison, Obergfell's invention is much more contrived and would require a lot more work to manufacture since one would not only have to create a headband 11 and make an opening in it, but they would have to separately create a donut shaped

ponytail holder 14 and then attach the two together. This would not only make Obergfell's device expensive to manufacture but it would also make it commercially less viable.

f) The current invention is superior to Obergfell's device in additional ways. The device of the current invention is a dual purpose device. It can be worn as an ordinary headband. In such a use the slit remains hidden and unused under the hair of the user. Such a use would not product esthetic results with Obergfell's device since the donut shaped ponytail holder 14 would cause an unattractive bump if hidden under the hair of the user.

g) The headband of the current invention is licensed to one of the largest manufacturers of hair accessories in this country, L&N Sales and Marketing (also known as Scunci International), now a division of Conair Corporation. L&N Sales and Marketing has a long history of licensing inventions. They have a widely acknowledged expertise in selecting novel, commercially-viable inventions. The fact that they have chosen to license the headband of this invention is evidence of the novelty and unobviousness of the headband of this invention.

i. Keeping examiner's objection in mind, and to make the novelty of the current invention more distinct over Obergfell's applicant has amended claim 1 to include the word, "elongated" to describe the opening. Additionally, applicant has added the following to claim 1: "said opening being of a dimension to avoid bunching wearer's hair into a small, kink-forming diameter".

### **The Rejection of Claim 5 on Obergfell in view of Huff under 35 U.S.C. 103**

The last office action rejected Claim 5 as being unpatentable over Obergfell in view of Huff. The office action stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to put the band of Obergfell around the user's neck, as taught by Huff, in order to decorate a user's neck while providing a ponytail holder. Applicant has amended claim 5 to better reflect the novelty of the current invention over Obergfell in view of Huff. Applicant requests reconsideration of the amended claim for the following reasons:

- a) Neither of the prior art references, Obergfell or Huff teach that the headband by Obergfell be used around the neck.
- b) However, even if Obergfell's headband were used around the neck in the manner of Huff's device, the result would be awkward and unaesthetic. Obergfell's headband uses a donut shaped ponytail holder 14. If band 11 were placed around the neck and then the wearer's ponytail inserted through pony holder 14 then the hair would fall straight down from the head until the position of pony holder 14 and then awkwardly protrude out of the aperture of pony holder 14 causing a "bump" at the position of the pony-holder at the wearer's neck. Such a bump would feel uncomfortable when leaning back in a chair or lying down. It would also appear contrived. The profile of such a look would be awkward and pointless. In contrast, as seen in Fig 5 of the current invention,

the slit in the band allows hair to drape smoothly even after it has been inserted through the slit. The result is not only aesthetically pleasing but also natural looking, simulating the appearance of hair after a scarf or muffler has been wound around a wearer's neck and hair.

c) When the headband of the current invention is worn around the neck as shown in Fig 5 it helps control the wearer's hair without causing a kink in the hair that will require restyling. In contrast, the use of an aperture as opposed to an elongated slit in Obergfell's device will result in a kink in the wearer's hair. Thus once Obergfell's device is used on a wearer's hair, she will have to restyle her hair to wear it open without a headband. The headband of the current invention is superior in function since a wearer can use the headband of the current invention without having to restyle her hair after removing the headband. This is because the slit in the headband holds hair snugly but gently without bundling it into a small diameter. Because of the time and expense involved in getting their hair styled, most women like to preserve the look of their blow-dry or styling session for as long as they can. Using the headband of the current invention helps maintain the smooth look of a blow-dry. In contrast the use of Obergfell's invention will cause a kink in the hair and thus require time, effort and money to restyle hair.

d) The headband is licensed to one of the largest manufacturers of hair accessories in this country, L&N Sales and Licensing (also known as Scunci International), now a division of Conair Corporation. L&N Sales and Licensing, despite

its familiarity with the world of hair accessories, considered the headband of this invention novel enough to license it immediately on seeing it. Since then the headband is being sold through various retailers as a Cosmetic Wrap. This commercial acquiescence is testament to the unobviousness of the current invention.

Keeping examiner's objection in mind, and to better illustrate how the current invention is unobvious over Obergfell in view Huff, claim 5 has been amended to include the words "elongated" to describe the opening in the neck warmer of claim 5.

### **Conclusion**

Applicant has amended claims 1, 2 and 5 so that they are proper, definite, and define novel structure which is also unobvious. Applicant has canceled claims 3 and 4. Applicant respectfully submits that the amended claims all define patentably over the prior art and that this application is now in condition for allowance, which action she respectfully solicits.

Very respectfully,



Priti Srivastava

143 Juniper Hill Road  
White Plains, NY 10607  
Ph: 914 997 9823